REMARKS

The Office Action has been received and carefully considered. The Office Action rejects claims 1-9 under 35 U.S.C. § 101 and rejects claims 1-12 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,812,988 to Sandretto ("Sandretto"). Applicants respectfully traverse these rejections. Reconsideration of claims 1-12 is respectfully requested based on the following remarks.

I. The Rejection Under 35 U.S.C. § 101 Is Moot In View Of The Amendments

The rejection of claims 1-9 under 35 U.S.C. § 101 is moot in view of the amendments to claim 1 submitted herewith.

II. The Claimed Invention Is Patentable Over Sandretto

The Office Action rejects claims 1-12 under 35 U.S.C. § 102(b) as allegedly being anticipated by Sandretto. Applicants respectfully traverse this rejection as detailed below.

A. Sandretto Fails To Disclose A Legacy Enterprise

There appears to be a fundamental misunderstanding as to what is claimed in the present application. The claimed invention is directed to developing options for migration of legacy enterprise technology. A "legacy enterprise" may include hardware and software. The ordinary meaning of "legacy enterprise" does *not*, however, include any type of stock, bond, or other financial instrument. For example, one application of the claimed invention is to assist in making a purchase decision for new computer equipment for an entire corporation. The claimed invention is *not* directed to making investment decisions for stocks, bonds, or other financial instruments.

Independent claims 1, 10, 11 and 12 recite a "legacy enterprise." Sandretto fails to disclose this limitation. Sandretto is instead directed to obtaining financial information on certain financial products and financial assets. Sandretto lists the types of products and assets that his invention contemplates: stocks, bonds, real estate, newly-formed companies, bankrupt companies, derivative assets, and potential assets. Sandretto, col. 9, lines 60-65. Notably absent from that list is any reference to a legacy enterprise. Sandretto does not teach, consider, discuss, suggest, or in any way refer to any type of legacy enterprise. The limitation is simply not there.

That Sandretto fails to disclose a "legacy enterprise" is unsurprising. The Sandretto patent is directed to financial analysis of a fundamentally different thing: financial instruments and financial assets. Sandretto is not in the same inventive field of endeavor as the present invention.

Under 35 U.S.C. § 102, anticipation requires that a prior art reference disclose each and every element of the claimed invention. *In re Sun*, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). MPEP § 2131, quoting *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), reinforces this principle: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Because Sandretto fails to disclose a "legacy enterprise," Applicants respectfully request that the rejections of the claims be withdrawn.

B. Sandretto Fails To Disclose a Developing Migration Options For A Legacy Enterprise

The independent claims recite "developing the migration options" where the migration options are for a legacy enterprise. Sandretto completely fails to disclose this limitation.

As discussed above, Sandretto fails to disclose a "legacy transactional enterprise," let alone "developing migration options" for the same. Sandretto is directed to financial analysis of financial instruments and financial assets. Nowhere does Sandretto consider retiring old technology and adopting new technology. Sandretto does not refer to any options for changing computer systems. There is no discussion, consideration, teaching, or reference to developing migration options in Sandretto. Sandretto is directed to a completely different art: financial analysis of financial products and financial assets. As such, reliance on Sandretto for disclosure of developing migration options for a legacy enterprise is misplaced.

As discussed above, 35 U.S.C. § 102 requires that a prior art reference disclose each and every element of the claimed invention. *In re Sun*, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). MPEP § 2131, quoting *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), reinforces this principle: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Because Sandretto fails to disclose "developing the migration options" of a legacy enterprise, Applicants respectfully request that the rejections of the claims be withdrawn.

III. The Office Action in General

For the record, Applicant states here some concerns regarding the Office Action. In general, it is difficult to discern exactly what portions of the cited reference that the Examiner relies upon. For example, the Examiner repeatedly cites nearly seven pages from the applied patent as meeting certain claim limitations. *See, e.g.*, Office Action, page 3 (citing columns 15-28 as allegedly meeting the last two limitations of claim 1). Further, the Examiner cites *nearly twenty columns* in the rejection claim 1, which is only eleven lines long, without any analysis whatsoever. The Examiner copies the claim limitations into the Office Action without discussing how the voluminous citations allegedly meet the individual claim limitations. Applicants are adversely prejudiced because the rationale for rejection is effectively obscured or buried.

Further, the Office Action fails to properly consider each individual claim limitation. For example, the Office Action cites the same *fourteen columns* of Sandretto as allegedly meeting claims 2-6 and 9, each of which is only two lines long. Merely reproducing the claim limitations word-for-word in the Office Action without any accompanying analysis, other than voluminous citations, does not adequately give Applicants notice as to how the Examiner views the rejections. U.S. Patent Office policy demands that each claim limitation be considered and addressed, and Applicant requests the same. *See In re Lowry*, 32 F.3d 1579, 32 USPQ.2d 1031, 1034 (Fed. Cir. 1994) (*citing In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 405 (Fed. Cir. 1983)); *see also In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970) ("All words in a claim must be considered in judging the patentability of that claim against the prior art.").

IV. Conclusion

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

Applicant believes that no fee is required for entry of the present Reply. Nevertheless, in the event that a variant exists between the amount tendered and that determined by the U.S. Patent and Trademark Office to enter this Reply or to maintain the present application pending, please charge or credit such variance to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,
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Dated: June 25, 2007

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